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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,740	11/20/2001	Pekka Juhana Pihlaja	04770.00028	8949

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WASHINGTON, DC 20001

EXAMINER

TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/988,740	Applicant(s) PIHLAJA, PEKKA JUHANA	
	Examiner HENRY N TRAN	Art Unit 2674	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28,30,32,33,36-45,47,49-51 and 53-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43 and 44 is/are allowed.
- 6) ☒ Claim(s) 1-10,13-16,18,22,23,25,27,28,30,32,33,36-42,45,47,49-51,53-69 and 73-75 is/are rejected.
- 7) ☒ Claim(s) 11,12,17,19-21,24,26 and 70-72 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/29/04 & 10/5/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the applicant's amendment received 10/05/04. The amendments to the claims have been entered. Claims 1-28, 30, 32, 33, 36-45, 47, 49-51, 53-56, and 63-68 are pending in this application. Applicant's declarations and remarks have been fully considered, with the results set forth as follows.

1. Applicant's affidavits and arguments with respect to claims 19-22, 28, 30, 32, 33, 36-39 and 57-62 have been fully considered; and have overcome the rejections recited in the prior Office action; but are moot in view of the following new grounds of rejection.
2. The indicated allowability of claims 1-10, 13-16, 18, 22-23, 25, 27, 40-42, 45, 47, 49-51, 53-56, and 63-68 are withdrawn in view of the newly discovered references to Hayes, Jr. et al (U.S. Patent No. 6,131,047) and Armstrong et al (U.S. Patent No. 5,729,219). Rejections based on the newly cited references follow.

Information Disclosure Statement

3. The examiner has considered the references submitted with the information disclosure statements (IDSs) received 7/29/04 and 10/05/04 (see the attached forms PTO-1449).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 28, 36-39, and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by Armstrong et al (U.S. Patent No. 5,729,219, hereinafter referred to as "Armstrong").

Armstrong teaches a method for selecting GUI items 20 on a display screen 18 of a handheld electronic call radio 10 comprising the steps of: detecting movement of a fingertip 42 of a user over a first touch-sensitive input sensor area, which is a touchpad 22; moving a display pointer 26 over corresponding content displayed on the display screen 18, e.g., the pointer 26 is positioned at the title "Messages" 28; receiving touchpad signals; detecting touch screen location and screen coordinates, e.g., point 44; highlighting an item or icon; detecting second movement of the user's fingertip 42 over the touchpad, e.g., point 48; and receiving second input corresponding to the pointer 26 positioned at the selection word "select" 52 of the pulldown menu; see figures 1 and 5; col. 4, line 40 to col. 5, line 10. Claims 28, 36-39, and 74 are therefore rejected.

6. Claims 28, 30, 36-40, 47, 59-62, 74, and 75 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hayes, Jr. et al (U.S. Patent No. 6,131,047, hereinafter referred to "Hayes, Jr.").

Hayes, Jr. teaches a radiotelephone 100 comprising a casing 110 and a planar input device including keys 130 and holes of a speaker and a microphone housed on a front face of the case, see figures 1 and 3. Hayes, Jr. also teaches computer program instructions for performing method steps for selecting items displayed on the display 120 of the radiotelephone 100, comprising the steps of: detecting movement over touch pads, which are a first touch-sensitive strip 150a (or 150b) and a second touch-sensitive strip 150c for receiving horizontal and vertical

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input (Hayes, Jr. refers as “ row and column-oriented controls”) for determining the contact positions, for determining the screen position of a cursor 1120 displayed at a identified displayed icon 1110, which is highlighted; the highlighted icon 1110 is being selected based on a subsequence movement operation that is read on the claim term “second movement” ; see figures 3 and 11; col. 9, line 65 to col. 10, line 23. Although, Hayes, Jr. does not expressly teach that the touchpads, or the first touch-sensitive strip 150a (or 150b) and the second touch-sensitive strip 150c are resistant to sound interference. However, this sound resistance characteristic is inherently provided by the Hayes, Jr. ‘s touch-sensitive mounted at the surfaces of the housing 110. Claims 28, 30, 36-40, 47, 59-62, 74, and 75 are therefore rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-10, 13-16, 18, 22, 23, 25, 27, 32, 33, 41, 42, 45, 49-51, 53-58, 63-69, 73, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes, Jr. in view of Armstrong.

Hayes, Jr. teaches an apparatus and methods for performing graphical user interfaces (GUIs) on a portable electronic device, which is a mobile telephone 100, comprising: a display 120 on a front face; a first, a second, and a third linear input devices, which are contact-sensitive strips, 150a, 150b, and 150c, affixed along first, second, and third sides of the display screen and a control logic, which is the controller 220, for scrolling, highlighting, selecting, or other

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graphical operations on displayed icons or a cursor based on the user's contacts with the strips.

Hayes, Jr. also teaches the strips 150a and 150b are each arranged perpendicular to the strip 150c; the strips are resistive strips that sense pressure; a speaker and a microphone, each having 3 holes extending through the front face of the housing; see figures 1-3, 7 and 11; col. 3, lines 51-62; col. 4, line 64 to col. 5, line 47; col. 7, line 66 to col. 8, line 67; and col. 9, line 65 to col. 10, line 22. However, Hayes, Jr. does not teach: a planar input device arranged on the back face of the portable device, covering substantially the same amount of space on the back face as the display screen covering space on the front face of the portable device; the portable device identifies a point on the display screen responsive to input received through the planar input device using a crosshair display element; the speaker that outputs sound through at least one hole extending through the back face of the planar input device; and the method steps of altering a size or panning the content of a displayed image. Armstrong teaches: a portable electronic device, which is a selective call radio 10 comprising a planar input device, which is a touchpad 22, arranged on the back face 16 of the portable device, covering substantially the same amount of space on the back face as the display screen 18 covering space on the front face 14 of the housing 12 of the portable device; the portable device identifies a point on the display screen responsive to input received through the planar input device using a crosshair display element "X" 30; and a means for outputting an audible alert to the user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the Armstrong's teachings discussed above in the Hayes, Jr.'s device for producing the claimed invention because this would provide improved GUIs, which are effectively and conveniently performed to provide the enhanced functionality and reliability of user's inputs by enabling the use of two opposing

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major surfaces and side surfaces to provide touch-sensitive strips or touch pads. By this rationale, claims 1-10, 13-16, 18, 22, 23, 25, 27, 32, 33, 41, 42, 45, 49-51, 53-58, 63-69, 73, and 75 are rejected.

Allowable Subject Matter

8. Claims 43 and 44 allowed.
9. Claims 11, 12, 17, 19-21, 24, 26, and 71-72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. The Smith et al (U.S. Pub. No. US 2002/0158838 A1) has been disqualified as an applicable reference due to the Declarations submitted with the above-identified amendment.
11. Applicant's arguments with respect to rejected claims discussed in the prior Office action have been considered but are moot in view of the new grounds of rejection discussed above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They are U.S. Patents Nos.: 6,369,803; 5,615,384; and 5,598,527, which teach GUIs using touchpad or active edge user interface.

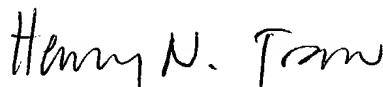
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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N TRAN whose telephone number is 703-308-8410.

The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A HJERPE can be reached on 703-305-4709. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HENRY N TRAN
Primary Examiner
Art Unit 2674

11/17/04